

REMARKS

In response to the various paragraphs of the Office Action, Applicants offer the following remarks:

(2) Format. Pursuant to the Examiner's request, Applicants have now shown claims 31-32 in a proper format for a Reissue application. Claim 31 (amended once) and claim 32 (not amended) are both shown entirely underlined.

(3) Concurrent Proceedings. The Examiner is already aware of the parent Reissue application and Divisional Reissue applications that are concurrently proceeding through the Patent Office with this Divisional Reissue application.

(4)-(5) Declaration. A Substitute Declaration, updating the errors corrected is enclosed, as requested by the Office. The Substitute Declaration is a copy of the Substitute Declaration submitted in the copending (parent) Reissue application, no. 09/588,364.

(6) Surrender of Patent. The original patent was surrendered to the Office in the copending Reissue application, no. 09/588,364, on November 22, 2002. As the original patent was lost, Applicants have submitted a communication in the copending (parent) Reissue application, no. 09/588,364, stating that the original patent had been lost (see enclosed copy of Communication, dated December 20, 2002).

(7)-(8) Double Patenting. The Office has rejected claims 31-32 because they claim the same invention as that of claims 1-12, 36-37 of copending Reissue application, no. 09/588,364. Applicants respectfully submit that claims 31-32 include features not found in claims 1-12, 36 and 37 of the copending Reissue

application and, therefore, cannot be the same invention for the reasons set forth below.

Amended Claim 31 now includes the following features:

- a data zone having pits...
- portions of the reflective layer being **trimmed by a laser** forming markings
- the markings form a barcode pattern...and are **formed on a track** of the optical disk...
- the **pits are provided between successive markings of the barcode pattern**. (The terms in bold are discussed below)

Claim 32 includes the following features:

- forming, on a substrate, a data zone having pits...
- **trimming the reflective layer to form markings on a track** of the optical disk, wherein the **markings form a barcode pattern**...
- the **pits are provided between successive markings** of the barcode pattern. (The terms in bold are discussed below)

Claims 1-12, 36 and 37 of the copending Reissue application each includes features not found in either claim 31 or 32. In addition, claims 31 and 32 include features not found in any of claims 1-12, 36 and 37. These sets of claims, therefore, are not identical inventions for the following reasons:

Claim 1 of the copending Reissue application includes at least two features not found in claim 31 or 32, namely "marking position detection means" and "position information output means." Moreover, claim 1 includes "marking forming means for applying at least one mark to the reflective film". Claim 31, on the other hand, includes "portions of the reflective layer being **trimmed by a laser**" and "the **markings form a barcode pattern**...and are **formed on a track** of the optical disk". In addition, claim 31 includes "**pits are provided between successive markings**". These features in bold are not found in claim 1. Claim 31 does not have identical subject matter as claim 1 and, thus, is not the "same invention" as claim 1. Claim 32 is a method claim, whereas claim 1 is an apparatus claim and, therefore, claim 1 cannot be the "same invention" as claim 32.

Claims 2-11 of the copending Reissue application depend from claim 1 and include additional features that limit claim 1. Consequently, claim 31 or claim 32 cannot be the same invention as claims 2-11 for at least the same reasons set forth above.

Claim 12 of the copending Reissue application includes "laminating the disk and another disk together" and "trimming the reflective film to form at least one marking by a laser on the reflective film." Claim 32, on the other hand, does **not** include laminating two disks together, and includes "trimming the reflective layer to form markings on a track of the optical disk, wherein the **markings form a barcode pattern**". In addition, claim 32 includes "**pits are provided between successive markings**". These features in bold are not found in claim 12. Claim 32 is thus not the "same invention" as claim 12. Furthermore, claim 31 is an apparatus claim, whereas claim 12 is a method claim and, therefore, claim 31 cannot be the "same invention" as claim 12.

Claim 36 of the copending Reissue application includes "a data zone indicating data signals". Claim 31, on the other hand, includes "a data zone **having pits**" and "portions of the reflective layer being **trimmed by a laser**". These features in bold are not found in claim 36. Claim 31 is thus not the "same invention" as claim 36. In addition, since claim 32 is a method claim and claim 36 is an apparatus claim, claim 32 cannot be the "same invention" as claim 36.

Claim 37 of the copending Reissue application includes "forming...a data zone indicating data signals". Claim 32, on the other hand, includes "forming a data zone **having pits**" and "the pits are provided **between successive markings of the barcode pattern**". These features in bold are not found in claim 37. Claim 32 is thus not the "same invention" as claim 37. In addition, since claim 31 is an apparatus claim and claim 37 is a method claim, claim 31 cannot be the "same invention" as claim 37.

Accordingly, Applicants respectfully submit that claims 31 and 32 of this application are not the same inventions (do not have identical subject matter) as any of claims 1-12, 36 and 37 of the copending Reissue application. Therefore, these sets of claims are not subject to a rejection in view of double patenting based on U.S.C. 101.

In the event that the Examiner rejects claims 31 and 32 in view of double patenting based on the obviousness kind (non-statutory), Applicants terminally disclaim a patent granted based on this application, and have thus enclosed a terminal disclaimer.

(9)-(10) Section 102 Rejection. The Office rejected claims 31 and 32 as being anticipated by Ikeda. Applicants submit that this rejection is overcome for the reasons set forth below.

Amended claim 31 now includes the following feature:

- portions of the reflective layer being **trimmed by a laser** forming markings,
- the markings form a barcode pattern indicating information and are formed on a track of the optical disk, and
- the **pits are provided between successive markings of the barcode pattern.**

Basis for “trimming” the reflective layer may be found, for example, in the specification at column 7, lines 4-7.

Ikeda, cited by the Examiner, discloses in Fig. 1, marks on disk 1. The marks contain pits (Fig. 2) indicating data signals. As understood by Applicants, Ikeda forms a reflective film on top of the pits (marks), so that the pits may be readable by an optical detector. Ikeda first forms the pits (marks) and then forms a reflective layer on top of the pits (marks). Ikeda does **not trim the reflective layer to form a mark**. Moreover, Ikeda does **not** trim the reflective layer **by a laser**.

Further still, Ikeda does **not** suggest **pits provided between successive markings of the barcode pattern**. As shown in FIG. 1 of Ikeda, pits are formed to indicate markings. Ikeda reads these pits within the markings by an optical detector. Ikeda, however, cannot have pits between successive markings, because he would not be able to distinguish between each marking that is formed by pits (FIG. 1) and would not be able to read the pits within each marking. In fact, Ikeda shows no pits between successive markings. Ikeda, therefore, does not disclose or suggest the features of claim 31.

Although claim 32 does not include trimming "by a laser", it does include other features similar to claim 31 and, therefore, is not subject to rejection in view of Ikeda for most of the same reasons set forth for claim 31.

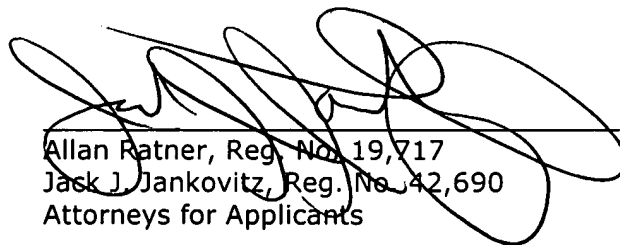
Reconsideration of claims 31 and 32 is respectfully requested.

Certificate Under 37 CFR 3.73 (b)

Applicants have now enclosed a better copy of an originally submitted Certificate Under 37 CFR 3.73 (b) in this Application. The title of the signer in the originally submitted Certificate is not clear. In the enclosed copy, the title is more clear. The stamp sets forth his name and title as "General Manager IP Development Center, Authorized Signing Officer". Page 1 of the Certificate sets forth that "The undersigned is empowered to act on behalf of the assignee." Applicants request that the Office substitute the enclosed copy for the originally submitted copy.

Respectfully Submitted,

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AR:kc

Enclosures: Substitute Declaration
Communication dated December 20, 2002
Terminal Disclaimer
Copy of Certificate Under 37 CFR 3.73 (b)

Dated: April 1, 2003

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The Assistant Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.